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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,766	12/08/2003	David M. Dundorf	104-003USANCO	3440

7590 02/25/2005

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,766

Applicant(s)

DUNDORF, DAVID M.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

PRIORITY

On page 1, lines 9-11 the applicant claims priority with regard to serial no. 08/600,609. However, the present application and serial no. 08/600,609 were not copending. In order to receive priority the applicant needs to list the intervening patent applications, i.e. 08/986,395 and 09/749,242 and 09/986,395.

Drawings

The drawings are objected to because descriptive matter appears in figures 3A, 3B, and 3D which is improper, i.e. "SLIDE TOP OF", "SLIDE LETTER", "UV FILTER". Descriptive matter should appear in the specification and not the figures. In figure 3D, the lead line for numeral "40A" is not directed to the projection and the lead line for numeral "41" is not directed to the UV film layer since the specification discloses on page 8, lines 35-37 that the UV layer is applied to the rear surface of the window. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to

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obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because on line 4, "b" should be "be". On lines 5 and 8, "parallelly" is not a word. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: The specification is replete with missing letters to words and are too numerous to mention specifically. The applicant should carefully review the specification and make necessary corrections. Examples are as follows: on page 1, line 19, "nvironments" should be "environments", page 2, line 1, "signag" should be "signage", on page 3, line 2, "reduc" should be "reduce", on page 3, line 3, "typ" should be "type", page 3, line 4, "limit d" should be "limited". On page 1, line 11, "entirety ." should be "entirety.". On page 8, lines 32,34,37, and throughout the rest of the specification, "window 31" should be "window 35".

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,178,679. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 discloses a signboard, a pair of upper and lower tracks, a plurality of characters, and a character locking means/character protective viewing panel including fastening elements.

Claims 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,438,880. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 discloses a signboard, a pair of upper and lower tracks, a plurality of characters, and a character locking means/character protective viewing panel including fastening elements.

Claims 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,658,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 discloses a signboard, a pair of upper and lower tracks, a plurality of characters, and a character locking means/character protective viewing panel including fastening elements.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmanski et al. (U.S. Patent No. 5,189,822) in view of Richardson et al. (U.S. Patent No. 1,028,279) and Smith (U.S. Patent No. 5,890,306).

Schmanski et al. shows in figures 1-3 a changeable sign system comprising a signboard (20) having a planar surface, a pair of character holding tracks (16,18 and 16,18) extending in a parallel manner relative to each other and being affixed to the signboard, the tracks each having a back portion (16 and 16) spaced apart at a predetermined distance, a plurality of characters (the indicia) formed on a thin rectangular substrate (30) having a width less than the predetermined distance, and character locking means (32,34,28) operably associated with the tracks and the character, for preventing unauthorized removal of the characters from the upper and lower character tracks. Schmanski et al. does not disclose placing a plurality of substrates within the channel and does not disclose arranging the tracks in a horizontally extending direction, i.e. the tracks of Schmanski et al. extend in a vertical direction. Richardson et al. shows in figures 1-3 the idea of placing a plurality of character carrying substrates (16,17) within tracks. In view of the teachings of Richardson et al. it would have been obvious to one in the art to modify Schmanski et al. by providing a plurality of character carrying substrates since this would allow parts of the display to be changed without having to replace the entire display. Smith shows in figures 1 and 2 the idea of arranging a display in either a vertical or horizontal direction. In view

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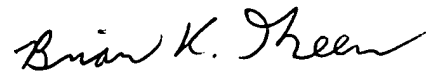
of the teachings of Smith it would have been obvious to one in the art to modify Schmanski et al. by arranging the display (which means the tracks would extend in a horizontal direction) in a horizontal direction since this would allow the device to be arranged in a more convenient and aesthetically pleasing manner on certain types of surfaces and would allow the indicia to be viewed in a better manner on certain types of surfaces. When the device of Schmanski et al. is arranged in a horizontal direction the tracks would include an upper track and a lower track and the substrate/substrates would include a height which is less than the predetermined distance. In regard to claim 3, Schmanski et al. shows in figure 1 a pair of character locking strips (34,34) which cooperate with the tracks to prevent unauthorized removal of the characters. In regard to claim 4, Schmanski et al. shows in figure 1 a character locking/viewing panel (28) of optically transparent construction which cooperates with the tracks to prevent unauthorized removal of the characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Feb. 22, 2005